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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,783	12/17/2001	Rainer Kirchhubele	Missling Case 369	6621

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EXAMINER

NGUYEN, THONG Q

ART UNIT PAPER NUMBER

2872

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,783

Applicant(s)

KIRCHHUEBEL ET AL.

Examiner

Thong Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13-26 is/are pending in the application.
- 4a) Of the above claim(s) 3 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9, 10 and 20-26 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-8 and 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The present Office action is made in response to the amendment (Paper No. 10) filed on 11/03/2003. It is noted that in the mentioned amendment, applicant has canceled claims 11-12 and added new claims 22-26 into the application.

A careful review of the newly-added claims has resulted that the device of the newly-added claim is similar in the scope of the device as claimed in the original claims; therefore, the pending claims 1-2, and 4-10 and 12-26 are examined in this Office action. Claim 3 is still not considered for the reason set forth in the restriction requirement (Paper No. 5) of 4/2/2003.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

3. The formal drawing contains fifteen sheets of figures 1-16 were received on 11/03/2003. These drawings are approved by the Examiner.

Specification

4. The lengthy specification which is amended by the amendment has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 13-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 13 is indefinite because it is unclear which optical device does applicant refer to in the feature thereof "the optical device is...spindle drive" (lines 2-4).

Applicant should note that the base claim recites two optical devices as can be seen in the first seven lines of the claim.

b) The remaining claims are dependent upon the rejected base claim and thus inherit the deficiencies thereof.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1, 4-7, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Volk (U.S. Patent No. 5,526,074) in view of Volk (U.S. Patent No. 5,200,773) (both of record).

Volk discloses a full field reinverting indirect contact ophthalmoscope. The system as described in column 6 and shown in figure 6 comprises two optical devices (12 and 16") disposed between a lens (18) of a microscope (20) and an eye to be treated (14). The two optical devices comprises a first optical device

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(12) which creates a reversed image (see columns 4-5) and a second optical device (16) comprises an image reversion and erection system consists of a prism system having two prisms in the form of Porro prism elements (100 and 102). It is inherently that the prism elements are supported by a housing having openings for permitting light entering and emerging the housing as can be seen in the arrangement of the prism elements shown in figure 6. See also element (42) of the embodiment disclosed in figure 2. While column 6 and fig. 6 does not clearly shown that the device (16") is supported by a holder; however, such use of a holder for supporting the optical device (16") is inherently disclosed because the use of a holder for supporting a similar device (16) is disclosed in columns 6-7 and shown in figure 4. The mechanism supporting the optical device (16) comprises a clamp (66) supporting the device (16) and pivotable about a swivel axle defined by the ball-and-socket (70) supported on a movable rod (72). The rod (72) is movable with respect to the guide rod (68) which is in turn pivotally supported by a system having ball-and-socket (86), etc.... See columns 6-7. With regard to the feature relating to the dimension of the device for reversion and erection image as recited on lines 8-9 of claim 1, such a feature without specific limitations relating to the specific height of the prism system is readable from the art of Volk. With regard to the use of a projection lens between the prism elements and the lens of the microscope, Volk discloses the use of a lens (64) for adjusting the optical path length. See column 7, lines 46+.

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The only feature missing from the art of Volk is that he does not disclose that the prism system is a set of Porro prism elements of type II as claimed; however, such use of the recited kind of prism system is merely that of a preferred embodiment and no criticality has been disclosed. The support for that conclusion is found in the present specification in which applicant has admitted that a plurality of different types of prism system can be used for the reversion and erection an image. Further, the use of conventional types of prism system including a set of Porro prism elements of type II is suggested to one skilled in the art as can be seen in the system provided by the same inventor, Volk, in his Patent 773, In particular, in the embodiments described in columns 10-15 and shown in figures 6-12, Volk '773 discloses an image inverting prism system made by a Schmidtpechan (figures 6-9) or by a set of Porro elements (figure 12). Thus, absent any showing of criticality and specific limitations of the prism system recited in the claim(s), it would have been obvious to one skilled in the art at the time the invention was made to utilize any suitable prism system known to one skilled in the art as suggested by Volk '733 in the microscope of Volk '074 for the purpose of reversion and erection an image to satisfy a particular/designed application.

9. Claims 1-2, 4-5, 7-8, 13-14 and 19, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as described in columns 2-3 and shown in figure 1 of the Patent issued to Luloh (U.S. Patent No. 5,793,524) in view of

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Missotten (WO 91/15150, submitted by applicant) and Volk (U.S. Patent No. 5,200,773, of record).

The prior art as described in columns 2-3 and shown in figure 1 of the Patent '524 discloses an optical device for non-contact wide-angle viewing of fundus. The system comprises a wide-angle lens system (22) supported by a carriage (30) which is able to move along an optical path of the microscope via the guide pin (32) and the threaded pin (34). It is also noted that the lens is attached to the carriage (30) via a telescopic tubes (26 and 28) which allows the movement of the lens along the optical path. The holder (12) also comprises an adapter (18) for attaching the holder to the microscope wherein a reduction lens (20) is provided. The device provided by the prior art does not disclose the use of an image reversion and erection system between the lens (22) and the microscope (10) for reversing and erecting the image provided by the lens (22). However, the use of an image reversion and erection system between a lens for reversed an image of an eye and a microscope is clearly known and suggested to one skilled in the art as can be seen in the system provided by Missotten. For instance, in the embodiment described in pages 3-4 and shown in figure 2, Missotten suggested the use of an image reversion and erection system (10) having a housing supporting a set of prism elements (5,7,8) between an eye to be treated (14) and a microscope (1) wherein the prism system is able to remove from the optical path of the microscope via a conventional prism moving mechanism. Thus, it would have been obvious to one skilled in the art to modify the

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microscope having an optical lens disposed in front of a microscope as provided by the prior art described in columns 2-3 and shown in figure 1 of the Patent'524 by installing an image reversion and erection prism system between the lens and the microscope as suggested by Missotten for the purpose of reversing and erecting the image provided by the lens.

The only feature missing from the art of Volk is that he does not disclose that the prism system is a set of Porro prism elements of type II as claimed; however, such use of the recited kind of prism system is merely that of a preferred embodiment and no criticality has been disclosed. The support for that conclusion is found in the present specification in which applicant has admitted that a plurality of different types of prism system can be used for the reversion and erection an image. Further, the use of conventional types of prism system including a set of Porro prism elements of type II is suggested to one skilled in the art as can be seen in the system provided by the same inventor, Volk, in his Patent 773, In particular, in the embodiments described in columns 10-15 and shown in figures 6-12, Volk '773 discloses an image inverting prism system made by a Schmidtpechan (figures 6-9) or by a set of Porro elements (figure 12). Thus, absent any showing of criticality and specific limitations of the prism system recited in the claim(s), it would have been obvious to one skilled in the art at the time the invention was made to utilize any suitable prism system known to one skilled in the art as suggested by Volk '733 in the combined product provided by

Volk '074 and Missotten for the purpose of reversion and erection an image to satisfy a particular/designed application.

Allowable Subject Matter

10. Claims 15-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claims 9-10 and 20-26 are allowed over the cited art.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

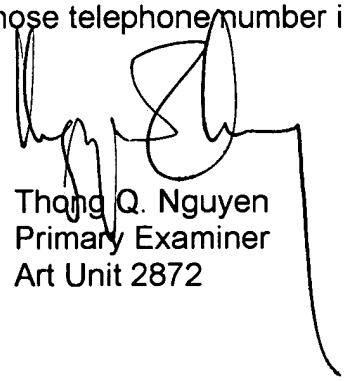
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (703) 308-4814. **Note that after Jan. 20, the Examiner may be reached at his new telephonic number of 571-272-2316.** The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (703) 305-0024. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.



Thong Q. Nguyen
Primary Examiner
Art Unit 2872

January 16, 2004